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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/674,094

09/29/2003

Laurence J. Cull

P03231

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EXAMINER

DEAK, LESLIE R

ART UNIT

PAPER NUMBER

3761

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No. 10/674,094	Applicant(s) CULL ET AL.	
	Examiner Leslie R. Deak	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,963,131 to Wortrich in view of US 4,416,772 to Sato et al.

In the specification and figures, Wortrich discloses the device substantially as claimed by applicant. With regard to claim 1, Wortrich discloses an elongated connector or waste line 79 that is connected to an ophthalmic pump cartridge 15 that provides a conduit for aspirated matter to flow from the cartridge to waste bag 100 (see FIG 2, column 6, lines 15-18). The connector or waste line is structured to connect to cartridge 15 (see FIG 2) with a second end in bag 100 (see column 6, lines 15-18).

Wortrich fails to disclose that the second end of the waste line or connector comprises a notched end. However, Sato discloses an apparatus for removing fluid from a patient comprising a connector line 21 that has a first end connected to a pumping apparatus and a second end positioned within the end of a collection bag 20 (see FIGS 4-5). The connector line 21 has a main body with slit elements or notches 22 disposed at the bag end of the connector line in order to provide a fluid passageway through the connector line 21 even when the bag 20 collapses around the line 21 due to negative pressure within the bag (see column 3, lines 6-25).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the connector line disclosed by Wortrich with a notched end as disclosed by Sato in order to provide a fluid flow pathway through the connector line even when the bag collapses around the connector line, as taught by Sato.

With regard to applicant's claim limitations drawn to the operation of the notch, such a statement is held by the examiner to be a statement of the intended use of the device. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. See MPEP 2114. In the instant case, the combination of Wortrich and Sato is capable of operating as claimed by applicant, since Sato teaches that the notched design prevents the bag from sealing against the conduit upon collapse. Applicant's claim language directed to the actions of the surgeon during the surgery fail to set forth any structural limitations that differentiate the structure of the instantly claimed invention from that of the prior art. Therefore, the prior art cited above meets the limitations of the claims.

With regard to claim 4, Sato discloses that the connector line may comprise two notches formed in opposing sides of the second end (see 22b in FIG 6).

3. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,963,131 to Wortrich in view of US 4,416,772 to Sato et al, further in view of US 4,930,997 to Bennett.

In the specification and figures, Wortrich and Sato disclose the device substantially as claimed by applicant (see rejection above), but are silent as to the manner in which the connector and the bag are sealed together.

Bennett discloses a medical suction apparatus with a collection tube 23 that connects suction device 20 to reservoir bag 120 (see FIG 1). The collection tube is heat sealed to collection bag 120 via sealing seam or ring 123 in order to create a tight seal without risk of liquid leakage (see column 15, lines 1-10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to seal the connector tubes and collection bags disclosed by Wortrich and Sato via a heat seal with a sealing ring as disclosed by Bennett in order to create a seal without risk of liquid leakage, as taught by Bennett.

Response to Arguments

4. Applicant's arguments filed 4 December 2006 with respect to the pending claims have been entered and considered but are unpersuasive.

5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., venting air during a surgical procedure) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant's claim language directed to the movement of air during the procedure is considered by the examiner to be a statement of the

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intended use of the claimed invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

See MPEP 2114. In the instant case, the structural limitations of the claimed invention are met by the prior art as discussed above. Air, as a gas, is a type of fluid. As such, a device that is disclosed as being a fluid venting device is capable of venting air, which is a fluid. Therefore, the prior art devices are capable of performing the intended use, thereby meeting the limitations of the claims.

6. Applicant argues that the references are not properly combined by the examiner, since one of ordinary skill in the art of ophthalmic surgery venting, as disclosed by Wortrich, would not consider the fluid handling system disclosed by Sato to remedy the problem solved by the instant invention. Applicant specifically argues that the instantly claimed invention is directed to air venting, while the Wortrich and Sato inventions are concerned with fluid venting. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both the Wortrich and Sato devices are concerned with controlling the movement of fluid (which may include air) in a confined path. Applicant's invention is directed to providing a conduit for aspirant to flow to a collection bags as well as providing for fluid movement of air through the system. Since

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the prior art and the instant invention provide solutions for the problems of directing fluid flow, the art is pertinent to the applicant's invention and properly combined to reject applicant's invention.

7. As such, the pending claims stand rejected over the prior art of record as set forth above.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

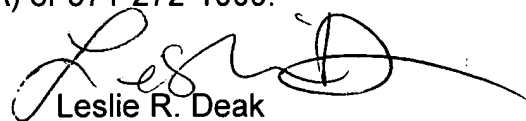
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie R. Deak whose telephone number is 571-272-4943. The examiner can normally be reached on M-F 7:30-5:00, every other Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Leslie R. Deak
Patent Examiner
Art Unit 3761
23 January 2007

TATYANA ZALUKAEVA
PRIMARY EXAMINER

